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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,719	12/03/2003	Keith A. Thuerk	BOC9-2003-0077 (448)	6364
40987	7590	01/21/2009	EXAMINER	
AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			FRITZ, BRADFORD F	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/726,719	THUERK, KEITH A.	
	<b>Examiner</b>	<b>Art Unit</b>	
	BRADFORD F. FRITZ	2441	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 October 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-5,8,10 and 26-37 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-5,8,10 and 26-37 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed 10/30/2008 have been fully considered but they are not persuasive.
2. In the remarks, applicant argued in substance that:

(A) Quillen does not teach selecting or designating at least one action associated with a group of subscribers via the graphical user interface of an instant messaging service.

As to point (A), the Examiner understands the Applicants' arguments and respectfully disagrees. First, the Examiner notes that the claim as amended requires "designating at least one action associated with the group via the graphical user interface".

The Applicant argues that Quillen cannot disclose this feature because Quillen teaches designating an action associated with a group using an icon that is outside of a communication application user interface. The Examiner notes that even though the icon is outside of one communication application interface (*the GUI in Fig. 7, item 205*), the icon is clearly part of another graphical user interface that provides an instant messaging service (see *Fig. 8, item 810*). In this embodiment the user can perform actions on the icons in the GUI (see *Fig. 8, item 810*) which provides an instant messaging service, which meets the above limitations in point A. In other words,

Quillen teaches two separate graphical user interfaces each providing an instant messaging services (the GUI in Fig. 7 and the GUI in Fig. 8).

More importantly, the Applicant must consider the reference as a whole. Quillen teaches that any action performed on the icon(s) “is the same as an action that would be executed in response to an operation performed on a representation of the contact of the contact or set of contacts in a user interface of the communications program” (column 1, lines 40-45 and Fig. 7). Accordingly, any action that can be performing using the icon method in Fig. 8 can also be perform within the GUI in Fig. 7.

(B) Quillen does not teach selecting a group of users with a list via a graphical user interface of an instant messaging service.

As to point (B), the Examiner respectfully disagrees. Quillen teaches selecting a group of users with a list via a graphical user interface of an instant messaging service (column 1, lines 40-45, column 10, lines 35-40, and Fig. 7).

(C) Prior art does not teach selecting a group of subscribers in an inactive state from a list or designating an action associated with the group.

As to point (C), the Examiner respectfully disagrees. Quillen clearly teaches designating an action associated with the group (column 10, lines 35-40 and column 12, lines 36-50).

(D) Prior art does not teach wherein the inactive state comprises at least one among an offline state, a do-not-disturb state, an away-from-desk state, an inactive state, and a state where an instant messaging session cannot be established with a subscriber.

As to point (D), the Examiner respectfully disagrees. First, the Examiner notes that the claim language “at least one” really means at least one. Both Quillen and Wick each teach at least one of an offline state, a do-not-disturb state, an away-from-desk state, an inactive state, and a state where an instant messaging session cannot be established with a subscriber. Applicant admits (*see page 9 in the remarks*) that Quillen teaches an idle state which is equivalent to the claimed inactive state. Also, Applicant admits (*see page 9 in the remarks*) “the inactive state that Wick allows a pounce for is only a pouncee’s signing on to the system”, this is equivalent to the claimed inactive state.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-4, 8, 10, 26-32, and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable by Wick (6,691,162) in view of Quillen (7,266,776), hereinafter referred to as Quillen.

5. Regarding claims 1, Wick disclosed displaying a user selectable list of subscribers of an instant messaging service; selecting a subscriber in an inactive state from the list (column 5, lines 6-55 and Fig. 5), designating at least one action associated with the [subscriber], the at least one designated action to be automatically performed with respect to each subscriber in the group in response to a state change (column 5, lines 6-55 and Fig. 5 and 4); automatically detecting a state change of at least one of said subscribers in said group (column 5, lines 6-55 and Fig. 5).

However, Wick does not explicitly teach selecting a group of subscribers within a list, designating at least one action with the group, the at least one designated action to be automatically performed with respect to each subscriber in the group in response to a state change, automatically executing said designated action associated with said group for said at least one subscriber responsive to said detecting step. Quillen teaches selecting a group of subscribers within a list (column 10, lines 35-40 and column 12, lines 36-50), designating at least one action with the group (column 10, lines 35-40 and column 12, lines 36-50), the at least one designated action to be automatically performed with respect to each subscriber in the group in response to a state change (column 10, lines 35-40 and column 12, lines 36-50), automatically executing said designated action associated with said group for said at least one subscriber responsive to said detecting step (column 10, lines 35-40 and column 12,

lines 36-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Quillen in the system of Wick because both are from the same field of endeavor and in order to “facilitate communications between computer users across a network” (see *title*).

6. Regarding claims 2 and 29, Wick disclosed wherein said action is an instant messaging initiation action that initiates an instant messaging session between said client and said at least one subscriber (column 5, lines 6-55 and Fig. 5).
7. Regarding claims 3 and 31, Wick disclosed wherein said action includes at least one action selected from the group consisting of a notification action (column 5, lines 6-55 and Fig. 5), a prompting action (column 5, lines 6-55 and Fig. 5), and a message conveyance action (column 5, lines 6-55 and Fig. 5).
8. Regarding claims 4 and 32, Wick disclosed wherein said selecting, said designating, said associating, said detecting, and said executing steps are performed by said instant messaging client (column 5, lines 6-55 and Fig. 5).
9. Regarding claim 8, Wick disclosed wherein said state change is a change from an inactive state to an active state (column 5, lines 6-55 and Fig. 5).
10. Regarding claim 10, Wick disclosed presenting within a graphical user interface a list of said subscribers (column 5, lines 6-55 and Fig. 5), and within said graphical user interface (Fig. 4-5), visually distinguishing said at least one subscriber from other subscribers in said list (column 5, lines 6-55 and Fig. 5).
11. Regarding claims 26 and 36, Quillen disclosed visually distinguishing said at least one subscriber from other subscribers comprises distinguishing based upon at

least one among a font color, a font type, a background color, and an icon type (column 10, lines 40-50).

12. Regarding claim 27, Wick disclosed wherein the inactive state comprises at least one among an offline state, a do-not-disturb state, an away-from-desk state, an out-of-office state, an inactive state resulting from an inactive state change, and a state where an instant messaging session cannot be established with a subscriber (column 2, lines 20-35).

13. Regarding claims 28, 34, and 37, Wick disclosed wherein the inactive state resulting from an inactive state change comprises a change from a current inactive state to a different inactive state (column 2, lines 20-35).

14. Regarding claim 29, Wick disclosed displaying a user selectable list of subscribers of an instant messaging service; selecting a subscriber in an inactive state from the list, wherein the inactive state comprises at least one among an offline state, a do-not-disturb state, an away-from-desk state, an out-of-office state, an inactive state resulting from an inactive state change, and a state where an instant messaging session cannot be established with a subscriber; designating at least one action associated with the [subscriber], the at least one designated action to be automatically performed with respect to each subscriber in the group in response to a state change; automatically detecting a state change of at least one of said subscribers in said group; and automatically executing said designated action associated with said group for said at least one subscriber responsive to said detecting step.

Wick teaches selecting one inactive user at a time to form a group of pounces (the “at least one action”). However, Wick may not explicitly teach a single selection for selecting a group. Quillen teaches selecting a group of subscribers from the list (column 1, lines 40-45, column 10, lines 35-40, and Fig. 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Quillen in the system of Wick because both are from the same field of endeavor and in order to “facilitate communications between computer users across a network” (see *title*).

15. Regarding claim 35, Wick disclosed wherein said at least one action further comprises presenting within a graphical user interface a list of said subscribers in said group and within said graphical user interface (column 8, lines 45-65 and Fig. 12), visually distinguishing said at least one subscriber from other subscribers in said list (column 8, lines 45-65 and Fig. 12).

16. Claims 5 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wick in view of Quillen, further in view of Ogle et al. (6,430,604), hereinafter referred to as Ogle.

17. Regarding claims 5 and 33, Wick and Quillen disclosed the invention as described above. However, neither explicitly teaches wherein said instant messaging client includes a Lotus Sametime (TM) type client. Ogle teaches wherein said instant messaging client includes a Lotus Sametime (TM) type client (column 1, 20-33). It would have been obvious to one of ordinary skill in the art at the time of invention to include the Lotus Sametime IM client in the system of Wick and Quillen because all are

from the same field of endeavor of instant messaging and in order to use Wick's "pounce" with another IM client.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

**a. Digate et al. (2004/0205134) teaches instant messaging program where a user can set up actions via a graphical user interface to be performed with an associated group when certain conditions are met. Specifically, when the status of members of the group changes.**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRADFORD F. FRITZ whose telephone number is (571)272-3860. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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